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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------|-------------|----------------------|---------------------|------------------|
| 10/076,542 | 02/15/2002 | Bernard A. McDonald | 21-0655 | 1679 |
| 40158 | 7590 | 06/16/2004 | EXAMINER | |
| LEONARD & PROEHL, PROF. L.L.C. | | | COLE, LAURA C | |
| 3500 SOUTH FIRST AVENUE CIRCLE | | | ART UNIT | |
| SUITE 250 | | | PAPER NUMBER | |
| SIOUX FALLS, SD 57105 | | | 1744 | |

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------|----------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/076,542 | MCDONALD, BERNARD A. |
| | Examiner Laura C Cole | Art Unit 1744 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 May 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-6 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 6 is/are allowed.
 6) Claim(s) 1-5 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 15 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date, _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheker, USPN 2,506,897.

Sheker discloses the claimed invention including a frame assembly (Figures 1 and 2) for being coupled to a vacuum (27), the frame having a base member (20, 21), a stanchion member (10), and an arm member (28), the arm member adaptable for coupling to a hose (H) of the shop vacuum (by hook members 31, 32), and a plurality of clip members coupled to the arm (again, hook members 31, 32), the hook members receiving the hose (Figures 1 and 2). The base member is capable of being adapted for coupling to the vacuum, the stanchion capable of being coupled to the base member. The base member comprises a base portion (where numerals "20" and "21" are indicated) and an extension portion (14, 15), the extension portion being coupled to the base portion such that the extension portion extends upwardly from a side edge of the base portion (Figure 1), the stanchion member coupled to the extension portion (near "16" and "17" in Figure 1) so that the stanchion member does not engage the base portion, the base portion for being coupled to the shop vacuum (via 24 and 25).

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Salisbury, USPN 2,453,863.

Salisbury discloses the claimed invention including a frame assembly (Figure 1) capable for being coupled, the frame having a base member (15, 16), a stanchion member (11), and an arm member (7), the arm member capable of coupling to a hose. The base member is capable of being adapted for coupling, the stanchion capable of being coupled to the base member. The frame has a coupling member (12, 13) extending through the stanchion member (Figure 1), the coupling member pivotally coupling the arm member to the stanchion member (Column 1 Lines 45-52), the stanchion member having a stanchion slot (unlabeled, where (12, 13) pass through) of which the coupling member extends through (Figure 1), the arm member having an arm slot (8), the coupling member extending through the stanchion member. The base member comprises a base portion (16) and an extension portion (18), the extension portion being coupled to the base portion such that the extension portion extends upwardly from a side edge of the base portion (Figure 1), the stanchion member coupled to the extension portion (at 14) so that the stanchion member does not engage the base portion (Figure 1.)

Allowable Subject Matter

3. Claim 6 is allowed.

4. The following is a statement of reasons for the indication of allowable subject matter:

None of the prior art made of record includes the combination of providing a device that has a frame comprising a base, a stanchion member having a stanchion slot pivotally coupled to a arm member having an arm slot, the coupling member extending through the stanchion member within the stanchion slot and arm slot, and having a plurality of clip members capable for receiving a hose of a shop vacuum.

Also, Claim 1 Line 4 recites “a frame assembly being *adapted for being coupled to a top of the shop vacuum.*” Similar language is recited in Line 9. If such language was perhaps replaced by “having means for”, it would then more positively claim such “adapt(ed)” or “couple(d)” structure, requiring an actual coupling device to a shop vacuum dust collection conversion device.

Applicants Arguments

5. In the response filed 04 May 2004, the Applicant contends that:

A. The Stoner reference does not teach or suggest a base member comprising a base portion and an extension portion, said extension portion being coupled to said base portion such that said extension portion extends upwardly from a side edge of said base portion, said stanchion member being coupled to said extension portion of said base member such that said stanchion member does not engage said base portion of said base member, said base portion for being coupled to the shop vacuum to allow said stanchion member to extend upwardly from the shop vacuum.

B. The Sheker reference does not teach or suggest a base member comprising a base portion and an extension portion, said extension portion being coupled to said base portion such that said extension portion extends upwardly from a side edge of said

base portion, said stanchion member being coupled to said extension portion of said base member such that said stanchion member does not engage said base portion of said base member, said base portion for being coupled to the shop vacuum to allow said stanchion member to extend upwardly from the shop vacuum.

C. The Epstein reference does not teach or suggest a base member comprising a base portion and an extension portion, said extension portion being coupled to said base portion such that said extension portion extends upwardly from a side edge of said base portion, said stanchion member being coupled to said extension portion of said base member such that said stanchion member does not engage said base portion of said base member, said base portion for being coupled to the shop vacuum to allow said stanchion member to extend upwardly from the shop vacuum.

D. The Koshiyama reference does not teach or suggest a base member comprising a base portion and an extension portion, said extension portion being coupled to said base portion such that said extension portion extends upwardly from a side edge of said base portion, said stanchion member being coupled to said extension portion of said base member such that said stanchion member does not engage said base portion of said base member, said base portion for being coupled to the shop vacuum to allow said stanchion member to extend upwardly from the shop vacuum.

E. The Mills reference does not teach or suggest a base member comprising a base portion and an extension portion, said extension portion being coupled to said base portion such that said extension portion extends upwardly from a side edge of said base portion, said stanchion member being coupled to said extension portion of said

base member such that said stanchion member does not engage said base portion of said base member, said base portion for being coupled to the shop vacuum to allow said stanchion member to extend upwardly from the shop vacuum.

F. The Salisbury reference does not teach or suggest a base member comprising a base portion and an extension portion, said extension portion being coupled to said base portion such that said extension portion extends upwardly from a side edge of said base portion, said stanchion member being coupled to said extension portion of said base member such that said stanchion member does not engage said base portion of said base member, said base portion for being coupled to the shop vacuum to allow said stanchion member to extend upwardly from the shop vacuum.

Response to Arguments

6. Applicant's arguments A and C-E, see response, filed 04 May 2004, with respect to 35 U.S.C. 102 (b) to Stoner, Epstein, and Koshiyama have been fully considered and are persuasive. The rejections in view of Stoner, Epstein, and Koshiyama have been withdrawn.

7. Applicant's arguments B and F filed 04 May 2004 have been fully considered but they are not persuasive.

Both Sheker and Salisbury include a base member comprising a base portion and an extension portion, said extension portion being coupled to said base portion such that said extension portion extends upwardly from a side edge of said base portion, said stanchion member being coupled to said extension portion of said base member such that said stanchion member does not engage said base portion of said

base member, said base portion for being coupled to the shop vacuum to allow said stanchion member to extend upwardly from the shop vacuum.

Although the device of Salisbury is not for a vacuum device, it includes all recited structure as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C Cole whose telephone number is (571) 272-1272. The examiner can normally be reached on Monday-Thursday, 7:30am - 5pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LCC
LCC

11 June 2004


Terrence R. Till
Primary Examiner